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EXAMINER				
GRABOWSKI, KYLE ROBERT				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/576,727

Applicant(s)

DEAN, JULIA RUTH

Examiner

Kyle Grabowski

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-9, 11-16, 19, 21-34, 38-47, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoppe (US 4,307,899) in view of *Understanding Halftones*.

4. In respect to claims 1-5, 24, 27-33, 38, and 43, Hoppe discloses a document or article carrying a security device provided on a substrate, comprising: at least one printed or transferred first area 11, each first area having at least one first color (red); at least one printed or transferred second area 12 (formed of printed layer 4) on the same side of the substrate as the first area, each second area having at least one second

color (white), and wherein the first area 11 surrounds the second area 12, each first area being distinguishable from the second area, the first area defining a border of the second area, and wherein at least first area and the second area defines an image "7"; and a camouflage pattern ("reflective media") 8 provided over the image and at least an adjacent region surrounding the image on the same side of the substrate the camouflage pattern having a color (white) and a pattern such that in combination with the first and second areas, the camouflage pattern renders the image substantially invisible when viewed under reflected light but visible when viewed in transmission (Abstract, Fig. 2a/b).

5. Hoppe discloses an offset printing process (Col. 3, 3-5) and that any number of colors (Col. 5, 27-31) may be used for the areas but does not explicitly disclose that at least one of the first and second areas comprises a discontinuous pattern. Inherent in an offset process however is a series of halftones (regularly spaced circular dots, also forming "fine lines") that in all but a few basic cases (pure magenta) result in a discontinuous pattern (e.g. lighter shades of red resulting from varying degrees of underlying paper or black halftones for darker shades). In any case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a colored area on the security feature disclosed in Hoppe with a discontinuous pattern (e.g. pink; a red discontinuous halftone patter) as the first area (or second area) in view of *Understanding Halftones*. The claim would have been obvious because a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation

but of ordinary common sense. The properties of offset printing and their intrinsic halftones are known as taught in *Understanding Halftones*.

6. In respect to claims 6, 9, 13-14, 44-47, as discussed above, Hoppe discloses printing processes such as offset printing which provide dots or halftones of ink but does not disclose particular sizes or ink coverage of the halftones (used for either the discontinuous pattern of the first indicia or the camouflage pattern) however *Understanding Halftones* discloses the relationships between ink coverage, dot size, spacing, etc. and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide dot or element sizes for the discontinuous pattern and camouflage pattern taught in Howland et al. with suitable sizes and/or ink coverage in view of *Understanding Halftones* to provide sufficient functionality to the invention as described (Abstract, Howland et al.). The claim would have been obvious because a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary common sense. Modifying ink density by spacing and size of halftones is well known in the printing art and it is within the technical grasp of one of ordinary skill in the art to modify these dimensions to provide an expected result (e.g. providing less ink coverage to allow for more light transmission). Furthermore, there is no criticality present in the specification for the specific ranges claimed (e.g. to "generally provide 50-80% ink coverage" or to provide a discontinuous pattern that will be "typically less than 1.5mm" Pg 4)

7. In respect to claim 7, Hoppe further discloses that the camouflage pattern 8 and area 4 are both white.

8. In respect to claims 8, 11-12, 15-16, and 23, non-specific color variations are taught by Hoppe as discussed above and further color variation (e.g. rainbow pattern) are within the technical grasp of one of ordinary skill in the printing art.

9. In respect to claims 19, 21-22, and 25, Hoppe doesn't disclose the specific procedural steps however, although a product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

10. In respect to claim 26 and 41, Hoppe discloses that the printed layers may be applied as a patch (e.g. laminated plastic) which naturally utilizes an adhesive (Abstract).

11. In respect to claim 34, Hoppe discloses that the first and second areas may be overprinted with an image 9 (also "7") in white ink (Fig. 2a).

12. In respect to claim 39, Hoppe discloses that additional printed effects "hallmarks" may be integrated into the surrounding areas (outside the security element) therefore rendering the area comparatively more transparent (not having the hallmarks which will add at least some opacity) (Col. 4, 58-67).

13. In respect to claims 40 and 42, Hoppe discloses that the substrate may be paper; the usage of the paper as a banknote is an intended use of the invention.

14. Claims 10, 17-18, 20, and 35-37, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoppe (US 4,307,899) in view of *Understanding Halftones* as applied to claims 1 and 33 above, and further in view of Howland et al. (US 6,089,614).

15. In respect to claim 10, 17-18, and 20, Hoppe and *Understanding Halftones* substantially disclose the claimed subject matter for the reasons stated above but do not disclose the camouflage layer pattern being a line pattern or a demetallized pattern however Howland et al. discloses a very similar invention with a similar camouflage layer 10 (which also hides underlying indicia) and that it may be formed of a line pattern by for example a demetallization process (Col. 7, 59-Col. 8, 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the white print camouflage pattern taught in Hoppe with a partially metallized camouflage layer taught in Howland et al. The substitution would not destroy either invention, in fact, Howland et al. also discloses a pearlescent white camouflage (similar to Hoppe) as equally permissible. In both cases the camouflage is reflective, hiding underlying indicia, but permissive to transmissive light. Substituting the white ink layer for a demetallized layer would in Hoppe would not alter or destroy the invention, and would predicatively serve an identical function.

16. In respect to claims 35-37, Hoppe discloses using any desired inks with additional effects (Col. 4, 58-69) but does not disclose using specifically OVI or metallic

inks however Howland et al teach that the first indicia 7 (comparable to the first area 11 in Hoppe) may comprise metal inks or optically variable inks (Col. 8, 12-19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the fluorescent ink taught in Hoppe as a metallic or OVI ink layer in view of Howland et al. as an appropriate ink with additional security properties. Hoppe discloses that such properties are desirable for additional security (Col. 5, 23-28). Metal and OVI inks are known, as taught by Howland et al. and substituting the inks would provide the predictable result of incorporating the additional security benefits of metallic or OVI inks (for scanning or providing a optically observable feature).

Response to Arguments

17. In respect to claims 1-43, the arguments filed on 07/10/09 have been considered but are moot because of a new grounds of rejection. Claims 44-47 are newly presented. The 35 U.S.C. 112 rejection is withdrawn.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Grabowski whose telephone number is (571)270-3518. The examiner can normally be reached on Monday-Thursday, every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571)272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle Grabowski/
Examiner, Art Unit 3725

/Dana Ross/
Supervisory Patent Examiner, Art
Unit 3725